REMARKS

Claims 13 and 29 are amended. Claims 1-33 are pending for consideration. In view of the following remarks, Applicant respectfully traverses the Office's rejections and requests that the application be forwarded on to issuance.

§ 112 Rejections

Claims 13 and 29 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for lacking antecedent basis for some of the terminology used in the claims. These claims have been amended to address and traverse the rejection.

Claims 11 and 20 continue to be rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office states that it is unclear whether these claims are dependent or independent claims because claims 1 and 12 are method claims and claims 11 and 20, which depend respectively from these claims, are storage medium claims.

Applicant respectfully submits that these claims are not indefinite. Specifically, claim 11 recites *a computer system* comprising:

> *a storage medium* having stored therein a plurality of executable instructions; and
> *an execution unit*, coupled to the storage medium, *to execute at least a subset of the plurality of executable instructions to implement a method according to claim 1.*

Thus, this claim is directed to an apparatus that comprises instructions on a storage medium that are executable to implement the method of claim 1.

Claim 20 recites a storage medium with executable instructions which implement the method of claim 12.

Applicant respectfully submits that there is nothing indefinite about these claims. Applicant addressed this rejection in Applicant's last response and does not understand the nature of the Office's confusion. This type of claim is a widely used claim format as evidenced by the number of patents that have issued having claims drafted in a similar format.

The Patent Office apparently agrees with this assertion as evidenced by the results of a cursory search of the PTO database which uncovered a number of issued patents with claims written in the form objected to by the Office. Specifically, consider U.S. Patent Nos. 6,725,262, 6,716,102, and 6,674,918 exemplary claims of which are reproduced just below.

6,725,262

26. A computer-implemented method of synchronizing a configuration of resources on a plurality of computing devices comprising:
generating a set of lists that describes a configuration of resources that each of a plurality of computing devices should have in order to be synchronized with one another, the configuration of resources defining the content and the settings for each of the computing devices;
sending the set of lists to each of the computing devices;
receiving a response from one or more of the computing devices, each response requesting data that is needed in order to synchronize the configuration of resources for the corresponding computing device;
evaluating the response to determine what data is needed by a particular computing device to synchronize its resources; and
sending the data that is needed by the particular computing device to the computing device so that it can synchronize its resources.

33. *One or more computer-readable media* having computer-readable instructions thereon which, when executed by a computer, implement the method of claim 26.

Here, claim 26 recites a computer-implemented method. Claim 33, which depends from claim 26, recites one or more computer-readable media with instructions which, when executed, implement the method of claim 26.

6,716,102

27. A method comprising:
    receiving a request to save a game being executed by a gaming system;
        saving a graphic representation of the saved game;
        saving a descriptive name of the saved game; and
        saving a date and time that the game was saved.

34. *One or more computer-readable media* comprising computer-executable instructions that, when executed, perform the method as recited in claim 27.

Here, claim 27 recites a method. Claim 34, which depends from claim 27, recites one or more computer-readable media with instructions which, when executed, perform the method of claim 27.

6,674,918

1. A computer-implemented method of synthesizing an image from at least two other images comprising:
        acquiring a first image that serves as a color source for a resultant image which is to be formed;
        acquiring a second image which serves as a perturbation source for the first image;

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PAGE 14/21 * RCVD AT 1/19/2005 4:38:42 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729306 * CSID:509 323 8979 * DURATION (mm-ss):05-38

operating upon a plane that represents the first image by angularly perturbing vectors associated with the plane that represents the first image as a function of aspects of the second image to provide a perturbed image; and

applying an illumination model to the perturbed image to provide a resultant synthesized image.

9. One or more computer-readable media having computer-readable instructions thereon which, when executed by a computer, implement the method of claim 1.

Here, claim 1 recites a computer-implemented method. Claim 9, which depends from claim 1, recites one or more computer-readable media with instructions which, when executed, perform the method of claim 1.

Accordingly, Applicant respectfully submits that there is nothing indefinite about these claims. Specifically, these claims are *dependent* claims which happen to recite a different statutory class of subject matter than their corresponding independent claims--in much the same way that *product-by-process* claims do.

As the Patent Office appears to agree with this assertion, Applicant respectfully traverses the Offices rejection.

§ 103 Rejections

Claims 1-22 and 26-33 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,581,102 to Amini et al. (hereinafter "Amini") in view of U.S. Patent No. 6,173,364 to Zenchelsky et al. (hereinafter "Zenchelsky").

Claims 23-25 stand rejected under 35 U.S.C. §103(a) over Amini in view of Zenchelsky in further view of U.S. Patent No. 6,255,943 to Lewis et al. (hereinafter "Lewis").

Before addressing the Office's current rejections, the following section on the §103 standard is provided. Applicant respectfully submits that the Office has not established a *prima facie* case of obviousness and, for at least this reason, these claims are allowable.

§103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent

has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for *specificity* pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("*particular findings* must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed") (emphasis added).

Applicant respectfully submits that the Office's stated motivation in making its combinations of Amini and Zenchelsky (i.e. to "*provide an efficient way* to implement the rules of a dynamic rule without having to search the entire

rule base for each packet."), and Amini, Zenchelsky and Lewis (i.e. to *"increase performance and reliability* of passing an object from a server to a client application") does not establish a *prima facie* case of obviousness.

Additionally, and of particular interest in this case, is a reference article published by the Office and available at:

http://www.uspto.gov/web/menu/busmeth103rej.htm.

This article provides examples of legally appropriate and legally inappropriate rejections under § 103. Particularly instructive, in the present situation, is Example 17 which is reproduced in its entirety below:

Example 17: Improper rejection based upon hindsight - general motivation statement.

a. The claimed invention

The invention is drawn to a smart card containing a tracking mechanism, which tracks shopping preferences of consumers by recording the type, quantity, and dates of purchase for a pre-selected group of products. The smart card is useful in a system and method for introducing new and alternative products that are of the same type as products normally purchased by the shopper. The smart card records the shopper's purchases and submits an automatic notification to the shopper when a quantity threshold is achieved for the pre-selected products. This notification will encourage the consumer to consider alternative products by providing the consumer incentives, such as a pricing discount, to purchase an alternative product.

Claim 1:

A method for using a smart card in a marketing analysis program designed to introduce new products, the method comprising the steps of:

storing product information on the smart card when said products are purchased by a consumer wherein said information including type, quantity and dates of the product purchased;

identifying for each product a threshold for each of said type, quantity and dates of products purchased;

determining an incentive for an alternative product based on said threshold; and

automatically notifying said consumer when said threshold is reached for a given product identified on the smart card and providing the consumer with said incentive, whereby the incentive encourages the consumer to consider alternative products.

b. Evidence

Reference A discloses smart card that tracks consumer preferences by recording the type, quantity, and dates of purchase of pre-selected products to determine trends in consumer purchases. The smart card is periodically read by a scanner to determine its contents for market analysis. In return for using the smart card and participating in the marketing program, the user is provided with free product coupons for products that are normally purchased by the shopper.

Reference B discloses a traditional consumer incentive program that provides coupons for the purchase of named products based upon the consumer's purchase of those same products to promote customer loyalty.

c. Poor statement of the rejection

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. Reference A discloses the conventional use of a smart card to track consumer preferences and provide incentives. However, Reference A does not disclose the automatic notification to consumer providing incentives. Reference B discloses providing incentives to consumers to purchase the desired products. *It would have been obvious to combine Reference A's smart card with Reference B's incentive to consumers because the combination would allow Reference A's smart card to be more efficient.*

d. Analysis

The motivation, improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious. Additionally, there is nothing in either of references that would suggest automatically notifying the consumer when reaching a threshold nor is there anything in either reference that would suggest the notifying step. Finally, although Reference B teaches a traditional coupon scheme to promote customer loyalty, there is no suggestion, other than applicant's disclosure, to employ this scheme to promote the introduction of new and alternative products. **The rejection is improper.**

The Office's Combination of Amini and Zenchelsky

In making out the rejection of claims 1-22 and 26-33, the Office argues that the motivation to combine Amini and Zenchelsky would be to "provide an efficient way to implement the rules of a dynamic rule without having to search the entire rule base for each packet."

Applicant respectfully submits that the Office's stated motivation – to provide an efficient way...– is, like the inappropriate motivation in the Office's own example above, simply too general because it could cover almost any alteration contemplated of Amini. As such, the Office has failed to establish a *prima facie* case of obviousness and these claims are allowable.

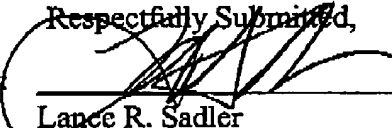### The Office's Combination of Amini, Zenchelsky and Lewis

In making out the rejection of claims 23-25, the Office argues that the motivation to combine these references would be to "increase performance and reliability...."

Applicant respectfully submits that the Office's stated motivation – increase performance and reliability ...– is, like the inappropriate motivation in the Office's own example above, simply too general because it could cover almost any alteration contemplated of these references. As such, the Office has failed to establish a *prima facie* case of obviousness and these claims are allowable.

Conclusion

All of the claims are in condition for allowance and Applicant respectfully requests a Notice of Allowability be issued forthwith. In the event that the Office's next action is anything other than issuance of a Notice of Allowability, Applicant respectfully requests that the undersigned be contacted for the purpose of scheduling an interview.

Dated: 1/19/05

By Respectfully Submitted,

Lance R. Sadler
Reg. No. 38,605
(509) 324-9256

LEE & HAYES, PLLC

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